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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/533,361	03/22/2000	Beatrice Toumi	6388-0501-0	9261

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[REDACTED] ART UNIT      [REDACTED] PAPER NUMBER

1617

DATE MAILED: 09/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/533,361

Applicant(s)

TOUMI ET AL.

Examiner

Lauren Q Wells

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) Responsive to communication(s) filed on 08 July 2002.

2a) This action is FINAL.                  2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) Claim(s) 1-30 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-30 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1) Notice of References Cited (PTO-892)

4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_

6) Other: \_\_\_\_\_

## **DETAILED ACTION**

The Amendment filed 7/8/02, amended claims 1-3, 20-21 and added claims 27-30.

### ***Request for Continued Examination***

The request filed on 7/8/02 for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/533361 is acceptable and an RCE has been established. An action on the RCE follows.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-26 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 30 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The instant specification does not define, slimming, firming, antiglycant and vasoprotective compounds as all the compounds listed in claim 30. While some of the listed compounds have support as slimming compounds, firming, antiglycant compounds, and vasoprotective compounds, independently, defining slimming, firming, antiglycant and vasoprotective compound as all the compounds listed in claim 30 is new matter.

Claims 1, 3 and 11-30 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the reduction of wrinkles and cutaneous aging, does not reasonably provide enablement for removing wrinkles and cutaneous aging. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

There are several guidelines when determining if the specification of an application allows the skilled artisan to practice the invention without undue experimentation. The factors to be considered in determining what constitutes undue experimentation were affirmed by the court in *In re Wands* (8 USPQ2d 1400 (CAFC 1986)). These factors are the quantity of experimentation; the amount of direction or guidance presented in the specification; the presence or absence of working examples; the nature of the invention; the state of the prior art; the level of skill of those in the art; predictability or unpredictability of the art; and the breadth of the claims.

The disclosure of the present invention is directed to a method of removing wrinkles and removing or reducing cutaneous ageing as set forth in independent claims 1 and 3. A skilled practitioner in the art using the teachings of Dalko et al. (6,255,297), Parab (5,885,596), Breton et al. (6,224,850), Koulbanis et al. (5,560,916), and Twine (2002/0081324) would be motivated to apply cosmetic compositions to treat wrinkles and cutaneous aging. However, removing cutaneous aging and wrinkles is inconsistent with what is known in the art since (1) reducing wrinkles/cutaneous aging indicates that wrinkles/cutaneous aging are decreased, but not removed; and (2) elimination of wrinkles/cutaneous aging indicates that symptoms of wrinkles/cutaneous aging may occur. Hence, the amount of guidance present in the specification, the absence of data indicating that wrinkles/cutaneous aging do not occur when the

instant composition is administered, and the state of the prior art indicating that the reduction of wrinkles/cutaneous aging using cosmetic compositions is possible, all indicate that reduction, not removal of wrinkles/cutaneous aging is possible.

The amount of guidance necessary to perform Applicant's invention would result in undue experimentation because the skilled artisan would be forced to randomly test numerous conditions and amounts of active agents in the instant invention to determine what compositions remove wrinkles/cutaneous aging. Hence, the amount of guidance present in the specification fails to present the necessary instruction such that one can readily determine the appropriate composition of claims 1 and 3.

**Note:** The Examiner reviewed Applicant's specification, but noted that the data does not indicate removal of wrinkles.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 11, 20-21 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- (i) The phrase "comprising a signs of cutaneous aging reducing or removing effective amount" in claim 1 (lines 2-3) is vague and indefinite, as it is confusing and unclear.
- (ii) The phrases "and one or more plant proteins" in claim 20 (line 4) and "and one or more slimming, firming, antiglycant and/or vasoprotective compounds" in claim 21 (lines 5-6) are vague and indefinite, as it is not clear if the proteins and compounds are a second constituent of the composition or if they are grafted onto the silicone polymer.

(iii) Claim 30 is rejected for the use of improper Markush groups. See MPEP 2173.05(h) for examples of proper conventional or alternative Markush-type language (e.g., "...selected from the group consisting of . . . and . . .").

(iv) The term "derivative(s)" in claim 30 (lines 5-7, 9) is vague and indefinite, as the metes and bounds of this claim are unascertainable. What chemical compounds are encompassed by this term? The specification does not further define these terms, and one of ordinary skill in the art would not be apprised of all the possible compounds encompassed by this term.

(v) The subject matter within parenthesis in claim 30 is vague and indefinite, as it is not clear whether this subject matter is being claimed.

(vi) The term "capable of" in claim 11 (line 5) is vague and indefinite. It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform that function. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

(vii) The terms "firming compound" and "antiglycant compound" in claim 21 (lines 5-6) are vague and indefinite, as it is not clear what chemical compounds are encompassed by these terms. The specification does not definitely define these terms and one of ordinary skill in the art would not be apprised of the chemical compounds or polymers encompassed by these phrases.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Kumar et al. (5,468,477).

Kumar et al. teach vinyl silicone polymers in cosmetic and personal care compositions. The compositions provide moisture-retaining properties by retarding the evaporation of moisture through the skin, and teaches foundations as cosmetic forms of the composition. Disclosed as the vinyl silicone polymers are grafted silicone polymers of formula (IV) of the instant invention. Isocetyl(meth)acrylate, isononyl (meth)acrylate, 2-ethylhexyl (methacrylate), acrylic acid, methacrylic acid, itaconic acid, and others are disclosed as monomers for “G3” and “G4” of formula (IV). The polymer is disclosed as comprising 5-60% of the composition. Exemplified is a face cream comprising 2% of a grafted mercapto-functional silicone polymer comprising ethylhexyl methacrylate and i-butyl methacrylate as vinyl monomers side-chains. It is noted that the limitations, “reducing or removing effective amount”, the “skin-tightening effective amount”, and the “wrinkle removing effective amount”, are inherently met, as these effective amounts, recited in claim 19 and the specification, encompass the effective amount of the exemplified face cream of Kumar et al.

Claims 1-3 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki et al. (5,219,560).

Suzuki et al. teach a face cream comprising 6% of an acryl-silicone graft copolymer and a hand cream comprising 10% of an acryl-silicone graft copolymer. It is noted that the limitations, “reducing or removing effective amount”, the “skin-tightening effective amount”, and the “wrinkle removing effective amount”, are inherently met, as these effective amounts, recited in

claim 19 of the claims and the specification, encompass the effective amounts of the exemplified face and hand creams of Suzuki et al.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 11-18, 24-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumar et al. (6,262,170).

Kumar et al. is applied as discussed above. The reference lacks an exemplification of a skin composition comprising a grafted silicone copolymer comprising at least one anionic non-silicone organic monomer and at least one hydrophobic non-silicone organic monomer.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Kumar et al. to exemplify a grafted copolymer comprising at least one anionic non-silicone organic monomer and at least one hydrophobic non-silicone organic monomer because Kumar et al. teaches that his grafted silicone copolymers can comprise both anionic non-silicone organic monomers and hydrophobic non-silicone organic monomers.

Claims 20-22 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumar et al. in view of Hasenoehrl et al. (6,190,678).

Kumar et al. is applied as discussed above. The reference lacks plant proteins. Hasenoehrl et al. teach cleansing and conditioning products for skin or hair with improved deposition of conditioning ingredients. Caffeine is disclosed as a skin barrier repair

active agent that helps repair and replenish the natural moisture barrier function of the epidermis.  
See abstract; Col. 34, lines 25-59.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the caffeine of Hasenoehrl et al. to the composition of Kumar et al. because Kumar et al. teach their compositions for the skin and for providing moisture-retaining properties, and Hasenoehrl et al. teach caffeine as a moisture-retaining active agent; hence, adding caffeine to the composition of Kumar et al. would be within the skill of one in the art.

#### ***Unexpected Results***

It is applicant's burden to demonstrate unexpected results over the closest prior art. See MPEP 716.02, also 716.02 (a) - (g). Furthermore, the unexpected results should be demonstrated with evidence that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance. *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992). Moreover, evidence as to any unexpected benefits must be "clear and convincing" *In re Lohr*, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173 USPQ 356 (CCPA 1972).

In the instant case, there are no unexpected results.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

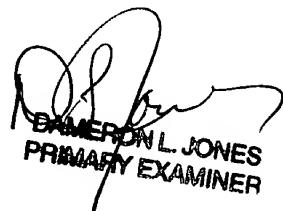
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russell S. Travers can be reached on (703)308-4603. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw  
August 2, 2002



CAMERON L. JONES  
PRIMARY EXAMINER